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REMARKS

Claims 1-10 were presented for examination. The Office Action rejects claims 1-10. This paper amends claims 1 and 9 and adds new claims 11-16. This amendment to claim 1 is to provide an antecedent basis for the term "threaded portion" in the claims. The amendment is not made in response to any particular objection or rejection raised in the Office Action. With respect to independent claim 9, a first amendment is similarly made to provide an antecedent basis for the term "threaded portion," and a second amendment to distinguish more clearly the Applicants' claimed stepped portion over the cited art.

Claims 1-16 are now pending in the application.

Rejection of claims 1-10 under 35 U.S.C. § 103(a)

The Office Action rejects claims 1-5, 7, 9, and 10 under 35 U.S.C. § 103(a) as being unpatentable over admitted prior art (APA) in view of Drake (U.S. Patent No. 6,746,193). The Office Action also rejects claim 6 as being unpatentable over APA in view of Drake and further in view of Palm (U.S. Patent No. 6,254,326) and claim 8 as being unpatentable over APA in view of Conlan (U.S. Patent No. 5,358,368). Applicants respectfully traverse the rejections because the APA and the cited references, whether taken alone or in combination, do not teach or suggest the Applicants' claimed invention.

The Applicants' invention relates to a fastener having a head portion, a shank with a threaded portion, and a stepped portion between the head portion and the threaded portion of the shank. As set forth in Applicants' representative claim 1, the diameter of the stepped portion enables the fastener to be used for round-hole and square-hole mounting rails. (Independent claim 9 recites this stepped portion as circular).

Drake discloses a clip assembly for use with round-type and square-type mounting rails. The clip assembly is a nut assembly for receiving and securing a bolt to a mounting rail of either type. The nut assembly has a locating surface (110) that is sized to fit within a square hole of the square-type mounting rails, but not within a round hole of a round-type mounting

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rail. The locating surface has a threaded opening extending therethrough. The bolt enters this threaded opening from the opposite side of the mounting rail and tightens against the mounting rail as the bolt further penetrates the locating surface.

Admittedly, Drake's locating surface bears some similarity to the Applicants' stepped portion in that both Drake's locating surface and the Applicants' stepped portion enter a square hole, but not into a round hole. To reject the Applicants' claimed fastener in view of Drake, the Office Action proposes modifying a prior art screw to incorporate Drake's locating surface. Nowhere in Drake, however, is this proposed modification taught or suggested. Moreover, Drake's locating surface also has a threaded bore passing therethrough for receiving a threaded bolt. In its proposed modification, the Office Action conveniently disregards the *threaded bore* and *bolt-receiving function* of Drake's locating surface. Using one attribute of Drake's locating surface to produce the Applicants' claimed fastener, while disregarding other attributes that are integral to the locating surface, is likewise nowhere taught or suggested.

Notwithstanding, the size and shape of Drake's locating surface also argue against simply modifying a screw to incorporate Drake's locating surface. According to Drake, the locating surface is "designed to fit snugly into the square-hole configuration" and is "preferably square shaped." (See col. 2, lines 55-63). This snug fit and square shape prevents rotation of the nut assembly while a bolt is being fastened thereto. While this result is desirable for a nut assembly, it is particularly disadvantageous for a screw if the screw cannot rotate when inserted into a square hole. In contrast, the Applicants' claimed fastener permits rotation because the *diameter* of the stepped portion is smaller the length of the side of a square hole (claim 1) or the stepped portion is *circular* in shape (claims 2 and 9). (See also paragraph 19 of the Applicants' specification). Therefore, Applicants' respectfully submit that the Applicants' claimed fastener is unobvious in view of Drake since modifying a fastener to include Drake's locating surface will render the fastener inoperable for its intended purpose. Accordingly, Applicants respectfully submit that claims 1-5, 7, 9, and 10 are patentably distinct over the cited references.

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Further, the fasteners disclosed in Palm and Conlan do not teach or suggest the stepped portion of the Applicants' claimed fastener as set forth in independent claims 1 and 9. Therefore, claims 6 and 8 which depend directly or indirectly from patentable independent claim 1 and includes all limitations of claim 1, are patentable for at least those reasons provided above for claim 1. With respect to newly added claims 11-16, each of these claims depends directly or indirectly from patentable independent claim 9 and includes all limitations of claim 9, are therefore patentable for at least those reasons provided above for claim 9.

CONCLUSION


In view of the arguments made herein, Applicants respectfully submit that the application is in condition for allowance, and therefore request early favorable action by the Examiner.

If the Examiner believes that a telephone conversation with the Applicants' representative would expedite allowance of this application, the Examiner is cordially invited to call the undersigned at (508) 303-0932.

Respectfully submitted,

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